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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,405	01/26/2001	Arthur W. Lauder	143-3US	4701
20212	7590	11/17/2003	EXAMINER	
THOMPSON LAMBERT SUITE 703D, CRYSTAL PARK TWO 2121 CRYSTAL DRIVE ARLINGTON, VA 22202			SCHIFFMAN, JORI	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/769,405

Applicant(s)

LAUDER, ARTHUR W.

Examiner

Jori R. Schiffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bair (US 4668117) in view of Beurer (US 3950017).

Regarding claims 1 and 7, Bair discloses a rod coupling comprising a tubular housing 10 having a first end adapted for a threaded connection 11 to a rod in a downhole rod string and a second end adapted for a threaded connection to a rod in a downhole rod string, the tubular housing having an exterior surface with a coating 15. As to claim 7, Bair also discloses a rod string formed of plural rods connected by plural rod couplings (Fig. 6). Bair fails to disclose the tubular housing having an interior surface defining a bore, the bore having plural openings extending transversely through the housing. Beurer teaches a tubular housing 12 with a bore extending therethrough and plural openings 18 extending transversely through the housing so polyurethane can flow through the holes to prevent separation of the connection. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to include a bore with plural openings extending transversely through the housing on Bair's rod coupling as disclosed in Beurer so the coating can flow through the holes to create a more secure connection on the coupling.

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As to claims 2 and 11, once the combination is made, modified Bair discloses the coating extending into the openings.

Regarding claims 4 and 8, modified Bair discloses openings that taper from the exterior surface of the housing to the interior surface (Fig. 3 of Beurer).

Referring to claims 5 and 9, modified Bair discloses the openings distributed uniformly around the tubular housing.

Regarding claims 6 and 10, modified Bair discloses the openings distributed in plural rows.

3. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bair (US 4668117) in view of Beurer (US 3950017) as applied to claims 1 and 7 above, and further in view of Edge (US 272033).

Regarding claims 3 and 12, modified Bair discloses the rod coupling as above except for the coating extending through the openings to form knobs inside the tubular housing. However, the formation of knobs would occur naturally since there is not anything to prevent the coating from extending into the bore, as discussed by Edge (lines 41-45). Therefore, it would have been obvious at the time the invention was made to a person of ordinary skill in the art for the coating on the housing of modified Bair to form knobs when it extends through the openings as disclosed in Edge.

#### ***Response to Arguments***

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the Examiner uses the motivation for the combination of Bair and Beurer from the specific teaching from Beurer in col. 2, l. 15-23 of the disclosure.

5. Applicant also argues that the Examiner uses Beurer to teach "two hollow ends of different diameters, slide one within the other, then case a block around them." In response, the Examiner respectfully disagrees because Beurer is only used to teach the feature of a bore through a rod and plural openings extending transversely therethrough. Beurer is not used to teach the diameter of the rods or casing around the rod.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jori R. Schiffman whose telephone number is 703-305-4805.


The examiner can normally be reached on M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1113.

Jori R. Schiffman  
Examiner  
Art Unit 3679

JS

  
Lynne H. Browne  
Supervisory Patent Examiner  
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